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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,013	08/05/2003	Gary Ashe	1584-3	7587

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EXAMINER

NGUYEN, TUAN N

ART UNIT PAPER NUMBER

3751

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/635,013

Applicant(s)

ASHE ET AL.

Examiner

Tuan N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 8,9 and 11-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/7/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species (I): Figs. 1-2, and  
Species (II): Figs. 3-7.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claim 1 is considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Walter Duft on September 16, 2004 a provisional election was made with traverse to prosecute the invention of Species (I), claims 1-7 and 10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8, 9 and 11-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Priority***

4. Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### ***Claim Objections***

5. Claim 4 is objected to because of the following informalities: "includes means a grip" is grammatically incorrect; therefore, it is unclear as to what is being claimed. Appropriate correction is required. Claim 4 is being examined as best understood as --gripping surface--.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4, 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kettle et al. (hereinafter Kettle).

In regard to claims 1, 4, 6 and 10, Kettle discloses a “disposable single-use” applicator assembly comprising a package (2) containing a fluid (3) to be dispensed (see Figs. 2a-3); an applicator (4) for dispensing the fluid, the applicator has a handle and a fluid holding element (5) at a first end portion of the handle; the fluid holding element being disposed in the package, a hermetic closure between a first end portion of the package and an intermediate portion of said handle (see Fig. 3); a second end portion of the handle having a gripping surface and extending clear of the package; and the package having a breakable portion (the strip seal of adhesive bond 8) proximate to the hermetic closure to allow the fluid holding element to be uncovered for use. The introductory statement of intended use have been carefully considered but are deemed not to describe any structure patentably distinguishable over Kettle device, which is certainly capable of being used in the claim manner.

In regard to claim 2, the Kettle handle second end portion is relatively thin in one dimension and relatively wide in another dimension (depend on the viewer, see Figs. 2a

and 2b) and includes a location (where numeral 4 is pointing) that is capable of being used to apply a name, trademark or other identifier, which is well-known in this art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kettle in view of Nicholson.

Although the applicator assembly of the Kettle reference does not include a hole or other opening in the handle second end portion, a formation of the hermetic closure at the handle intermediate portion, which is defined by flat first and second surfaces and non-tapered side, and a urethane foam material holding element as claimed, attention is directed to the Nicholson reference which discloses an analogous applicator assembly which further includes a handle having a hole in a second end portion thereof, a formation of the hermetic closure at the handle intermediate portion, which is defined by flat first and second surfaces and non-tapered side (see Fig. 10), and a holding element that can be made from a urethane foam material or bristle (see col. 3, line 64 et seq.).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ, on the Kettle handle, a hole as, for example, taught by Nicholson in order to hang the applicator for storage when not in use.

Furthermore, to move the placement of the hermetic closure of Kettle to flat first and

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second surfaces and non-tapered side of the intermediate portion of the handle, which is obvious to one of ordinary skill in the art as, for example, taught by Nicholson and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the bristle holding element (5) of Kettle with a urethane foam holding element as, for example, taught by Nicholson, where in so doing would involve mere substitution of one functional equivalent coating applicator means for another and the selection of any of these known equivalents to hold fluid therein and apply it to a surface would perform equally well on the Kettle device.

### ***Conclusion***


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Van Dyke et al. and Bennett disclose a container and applicator for fluids. Smith, Switzer, and Heroy, Jr. disclose other applicator assemblies with a package for covering a brush applicator. Corcoran, Menkin et al., and Wright disclose brushes with a foam applicator. Wattles discloses a strip seal similar to that of the instant invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 703-306-9046. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tuan Nguyen  
Primary Examiner  
Art Unit 3751  
9/16/04

TN